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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,791	02/28/2002	Etsuo Minamino	Q68612	3936
23373	7590	01/07/2004		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037				
			EXAMINER WILSON, DONALD R	
			ART UNIT 1713	PAPER NUMBER 12

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,791

Applicant(s)

MINAMINO ET AL.

Examiner

Donald R Wilson

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 11-13/03, has been fully considered with the following results.
2. The amendment overcomes the rejection of Claims 1 and 4 under 35 U.S.C. 102(b) as being anticipated by Merrill'048, and the rejection is withdrawn.
3. The amendment is not deemed to be persuasive in overcoming the remaining prior art rejections which are maintained for reasons discussed below.

Previously Cited Statutes

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Prior Art Rejections

5. **Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruepping.** The basis of this rejection was stated in Detailed Action § 2-3 of the previous Office Action.
6. Applicant traverses the rejection based upon an amendment to the claims specifying an iodine content as opposed to an iodine and/or bromine content. It is argued that none of the 22 working examples of Ruepping describes a composition of present Claim 1, and that Ruepping doesn't recognize the advantage iodo-containing comonomeric units as opposed to bromo-containing comonomeric units. This is not deemed to be persuasive because it is not necessary that the reference contain working examples of all that is disclosed. Further, as the reference is anticipatory for compositions having either bromo- or iodo-containing cure site monomers (bromo- and iodo-containing cure site monomers are disclosed to be preferred (col. 10, lines 37-40)), applicant cannot overcome the reference by claiming unexpected results.

The discovery of a new property or use of a previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to a known composition. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990).

"The absence of a disclosure relating to function does not defeat a finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product". *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431(Fed Cir 1997).

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7. **Claims 1-4, 8 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Yagi (U.S. Patent 5,169,902)¹, as evidenced by JP'491 or JP'310.** The basis of this rejection was stated in Detailed Action § 4-5 of the previous Office Action.

8. Applicant argues that Yagi doesn't specifically describe the fluoroelastomer, but appears to recognize that the description of the fluoroelastomers used by Yagi are known as evidenced by JP'410 or JP'310. It is also argued that the photoinitiator, camphorquinone, is used for polymerization of methyl methacrylate and not for cross-linking. This is not deemed to be persuasive because the polymerizable mixture contains both methyl methacrylate and a ethylene glycol dimethacrylate. Such a mixture when polymerized would become cross-linked due to the presence of the multifunctional acrylate. While subsequent heating is used to cross-link the fluoroelastomer, the limits of the instant claims are met at least by the photoinitiated cross-linking of the methacrylate and dimethacrylate mixture. It would also seem that some cross-linking of the fluoroelastomer occurs as the same ingredients as are present in the instant claims are used, i.e., an iodine containing polymer, a photoinitiator, and a polyfunctional unsaturated compound. The burden is on applicant to show otherwise.

Action Is Final

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 571-272-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone numbers for the organization where this

¹ The previous Office Action incorrectly made reference to Li as opposed to Yagi. It is appreciated as indicated by the amendment that applicant recognized the rejection was based upon Yagi (of record) and not of Li (not of record). Any inconvenience to applicant is regretted.

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application or proceeding is assigned is (703) 872-9306 for regular communications. The unofficial direct fax phone number to the Examiner's desk is 571-273-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

A handwritten signature in black ink, appearing to read 'DRW', with a long horizontal flourish extending to the right.

Donald R Wilson
Primary Examiner
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